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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/774,620 | 02/01/2001 | Tomoshi Hirayama | 202491US6 | 3053 |
| 22850 | 7590 | 10/29/2007 | | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER BLAIR, DOUGLAS B | |
| | | | ART UNIT 2142 | PAPER NUMBER |
| | | | NOTIFICATION DATE 10/29/2007 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/774,620

Applicant(s)

HIRAYAMA, TOMOSHI

Examiner

Douglas B. Blair

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2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 195-201 and 203 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 195-201 and 203 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/8/2007 have been fully considered but they are not persuasive.
2. With respect to the 101 rejection, the applicant seems to be confused regarding the nature of the rejection. The Examiner is not stating that software elements cannot be included within a claim. Instead, the 101 rejection is made because the **claimed** system is directed only towards software elements. If a system comprises only software elements then the system can only be software. The applicant has not pointed any portion of the applicant's specification that limits the interpretation of the term "system" to hardware.
3. With respect to the 103 rejection, the cited portion of Rangan reads on the claims because Rangan states that, "the hotspot linking is used to control security and access to videos" (col. 28, lines 34-35) and Rangan discusses a "security or e-commerce type of click" (col. 28, lines 43-44). So Rangan's hyperlinks can be considered to have "a validity term and conditions relate to the assignment of rights" because the hyperlinks cause a special type of click to be registered with Rangan's system.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 195 and 202-203 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 195 and 202-203 are directed towards a

system that comprises only software sections. Because these claims are directed towards software per se they do not fall into a statutory category of invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 195-201 and 203 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,006,265 to Rangan et al. in view of U.S. Patent Number 6,876,974 to Marsh et al.

8. As to claim 195, Rangan teaches a data-providing system comprising: a first data-transmitting section configured to transmit a continuous stream of content data including multimedia content groups, each including program data and auxiliary data items (col. 10, lines 12-47, the hypervideo is the program data and the hyperlinks are auxiliary data items); an edit control section configured to perform an editing operation on the attributes of each program data and auxiliary data items thereby automatically assembling new content data (col. 12, lines 42-62); and a second data transmitting section configured to select the auxiliary data items to be inserted into the program data in accordance with the new content data assembled by the edit control section, thereby to transmit a continuous stream of adapted content data that includes multimedia groups, each including the program data and the auxiliary data items (col. 10, lines 12-47); wherein the auxiliary data items include, at least, a validity term and conditions relative

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to the assignment of rights for editing attributes of the auxiliary data item (col. 28, lines 33-50); however, Rangan does not explicitly teach attributes including a conflict attribute identifying associated content data which is precluded from assembly with predetermined other content data for providing new content data.

Rangan does teach the inclusion of advertisement content within the content data (col. 12, lines 42-62). Marsh teaches a system for managing advertisements wherein attributes including a conflict attribute identifying associated content data which is precluded from assembly with predetermined other content data for providing new content data (Marsh, col. 9, line 66-col. 10, line 21).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Rangan regarding a data-providing system for transmitting multimedia content including advertisements with the teachings of Marsh regarding a conflict attribute for precluding the assembly of conflicting content because an advertiser would not want its ads assembled with a competitor (Marsh, col. 10, lines 3-4).

9. As to claim 196, Rangan teaches a system comprising: a data server apparatus configured to change the order of the items of the new content data which has been assembled by the edit control section and which includes multimedia content groups, each including the program data and the auxiliary data items, and configured to output the items of new content data in the order changed, thereby to transmit the new content data (col. 2, line 61-col. 3, line 15, hypervideo can be arranged in any unique order).

10. As to claim 197, Rangan teaches a system comprising: a data server apparatus configured to skip certain auxiliary data items contained in the new content which as been assembled by the

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edit control section and which includes multimedia content groups, each including the program data and the auxiliary data items, thereby to transmit the new content data (col. 4, lines 9-32).

11. As to claim 198, Rangan teaches a system comprising a data server apparatus configured to transmit additional auxiliary data items, together with the new content data which has been assembled by the edit control section and which includes multimedia content groups, each including the program data and the auxiliary data items (col. 12, lines 42-62).

12. As to claim 199, Rangan teaches a system wherein the data server apparatus acquires the additional auxiliary data items from an external system, by the use of the edit control section (col. 11, lines 4-19, URL's such as that of Ford must be acquired externally, i.e. from Ford).

13. As to claim 200, Rangan teaches a system wherein the data server apparatus incorporates a generator to generate additional auxiliary data items (col. 12, lines 42-62).

14. As to claim 201, Rangan teaches a system comprising a data terminal apparatus configured to change the order of the items of the new content data which has been assembled by the edit control section and which includes multimedia content groups, which including the program data and the auxiliary data items, and configured to transmit the items of the new content data in the order changed (col. 23, lines 30-35, the client can record the content and thus change the order the video is transmitted to the monitor).

15. As to claim 203, Marsh teaches a system wherein the conflict attribute identifies a list of conflicting content provider entities (col. 9, line 66-col. 10, line 21).

Conclusion

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16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is (571) 272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Douglas Blair

DBB



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER